REMARKS/ARGUMENTS

Claims 1-56 have been cancelled. New Claims 57-72 are pending in the application. Applicant believes that this response addresses the Examiner's rejections and that any changes do not introduce new matter into the specification, limit the scope of the claims or result in any prosecution history estoppel.

CLAIM REJECTIONS:

35 USC § 101

The Examiner has rejected originally filed claims 24-29 and 44-49 under 35 USC § 101 as being directed to non-statutory subject matter. Specifically, the Examiner has rejected these claims because their preambles recite a "machine-readable medium" and because this phrase is defined in the specification as including "electrical, optical, acoustical, or other forms of propagated signals (e.g., carrier waves, infrared signals, digital signals, etc.)" (Application, pages 3-4).

Applicant notes that claims 24-29 and 44-49 have been cancelled and that none of the new claims have preambles reciting a "machine-readable medium." Hence, Applicant believes that this rejection is now moot and respectively requests that the Examiner withdraw this rejection.

35 USC § 102(b)

The Examiner has rejected claims 1-56 under 35 USC § 102(b) as being anticipated by Turley ("Advanced 80386 Programming Techniques"). Applicant believes that new claims 57-72 are not anticipated by Turley.

Turley discloses a

...breakpoint opcode (that) is CC (11001100 binary)...(b)ecause the breakpoint opcode is only 1 byte, you can use it to replace any instruction...(w)hen the 80386 encounters the breakpoint opcode in the instruction stream, it fetches it and executes it like any normal instruction. When this instruction is executed, its sole purpose is to generate a breakpoint trap (exception 3). It does not affect any registers or flags...(s)ince the

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breakpoint is a trap, the instruction pointer saved on the stack will point to the byte immediately following the breakpoint's CC opcode. (Turley; page 326).

Thus, Turley appears to teach a breakpoint opcode or instruction that is one byte (eight bits) in size and, hence, that acts as or replaces an entire opcode or instruction in an instruction stream.

By contrast, new independent claim 57 recites

setting a first indicator, the first indicator comprising *only a portion of a computer program instruction*; and halting execution of the computer program instruction in response to setting the first indicator. (Claim 57, emphasis added).

The other pending independent claims recite similar limitations. Applicant asserts that Turley fails to disclose an indicator comprising only a portion of a computer program instruction. Rather, Turley discloses a breakpoint opcode or instruction that comprises an entire computer program instruction and not just a portion thereof.

Thus, in conclusion, Applicant asserts that the pending claims recite limitations that are not disclosed by Turley and, hence, that Turley does not anticipate these claims. Accordingly, Applicant respectfully asserts that all claims currently pending are in condition for allowance.
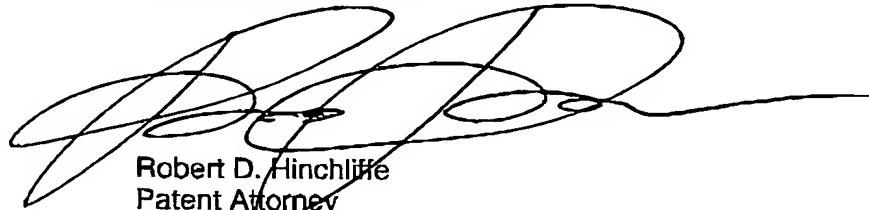
CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner has any questions, he is invited to contact the undersigned at (503) 264-6473.

Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,

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